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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/604,763	06/26/2000	Tsuyoshi Katayama	2185-0452P-SP	3604

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EXAMINER

WELLS, LAUREN Q

ART UNIT PAPER NUMBER

1617

DATE MAILED: 02/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/604,763

Applicant(s)

KATAYAMA ET AL.

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Claims 16-28 are pending. The Amendment received December 7, 2001 cancelled claims 1-15 and amended claims 18-28.

Request for Continued Examination

The request filed on January 14, 2002 for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/604763 is acceptable and an RCE has been established. An action on the RCE follows.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Kigawa et al. (5,798,434).

Kigawa et al. teach a monomer mixture and a method for the preparation thereof. The mixture consists of dimer diol/trimer triol mixtures which are subjected to esterification with alpha, beta-unsaturated carboxylic acids. The acids may have 3-8 carbon atoms. Methacrylic acid is specifically exemplified. Table 2 teaches a mixture of methacrylate esters of dimer diols/trimer triols. See abstract, Col. 1, line 40-Col. 2, line 44; Col. 3, lines 27-34; Col. 9, lines 1-17.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ansmann et al. (5,795,978) in view of Hartmann et al. (5,739,190) **or** in view of Akrongold et al. (3,846,550) in further view of Bernhardt et al. (4,788,054) **or** in further view of Clum et al. (5,652,263).

Ansmann et al. teach emulsifiers particularly suitable for the production of storable, high viscosity and sensorially light oil-in-water emulsions which are for use in cosmetic and/or pharmaceutical formulations. Suitable oils for said emulsions include esters of linear and/or branched fatty acids with polyhydric alcohols, for example dimmer diol or trimer diol, and/or Guebert alcohols. Suitable oils are disclosed as comprising 5-99% of the non-aqueous components of the emulsions. The reference fails to teach the number of carbon atoms the fatty acids comprise, rosin, dicarboxylic acids, the molecular weight and antioxidants. See abstract; Col. 1, lines 10-15; Col. 4, lines 39-56.

Hartmann et al. teach a process for the preparation of stable water-in-oil emulsions, wherein the emulsions are used as flocculating agents, retention agents and dispersing agents. The oily phase of the emulsion can consist of aliphatic dicarboxylic acid esters, wherein preferred acids are adipic and sebacic acids. Suitable water-in-oil emulsifiers include polyglycerol fatty acid esters made from polyhydric alcohols and long-chain fatty acids such as oleic, stearic, and palmitic acids. See abstract; Col. 1, lines 8-16; Col. 5, lines 29-33; Col. 6, line 66-Col. 7, line 36.

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Akrongold et al. teach a cosmetic skin powder containing urea, an oil phase and an inorganic pigment. Oils that may be used in the powder include acids and alcohols which may be saturated or unsaturated, straight or branched and comprising 5-52 carbons. Acids included for said oils are oleic, stearic, isostearic and dimer acids, and esters thereof. See abstract; Col. 1, lines 24-60.

Bernhardt et al. teach coating compositions comprising cosmetic emulsifiers and thickeners or viscosity modifiers. Suitable thickeners include ester gums which are semi-synthetic reaction products of rosin and a polyhydric alcohol. See abstract; Col. 8, line 38-Col. 9, line 16.

Clum et al. teach skin care compositions comprising a water-in-oil emulsion base. Oil-soluble antioxidants which are useful in said compositions include alpha tocopherol/vitamin E. See abstract; Col. 6, lines 10-17.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the teachings of Hartmann or Akrongold into the invention of Ansmann and obtain dimerdiol esters of carboxylic acids or monocarboxylic acids of fatty acids comprising 4-34 carbon atoms because a) all three reference teach emulsions comprising fatty alcohols, wherein the fatty alcohols are emulsifiers; b) Ansmann and Akrongold both teach emulsions comprising dimer acids; c) Ansmann teaches other fatty alcohols in his compositions as comprising 13-54 carbon atoms and Akrongold teach fatty acids comprising 5-52 carbon atoms and Hartmann teaches fatty acids comprising C10-C30 carbon atoms; hence, one of ordinary skill in the art would be motivated to look to Akrongold or Hartmann for suitable acids to form the esters of Akrongold.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Bernhardt into the invention of the combined references and obtain monocarboxylic acids comprising rosin or hydrogenated rosin because a) the combined references and Bernhardt all teach emulsions comprising fatty alcohols as emulsifiers; b) Bernhardt teaches that polyhydric alcohol esters, which encompasses fatty acid esters, of rosin increase the viscosity of emulsions, thereby thickening them; thus, since Bernhardt utilizes his rosin esters as thickeners in emulsions one would expect the rosin esters to have similar properties in other emulsions; hence, teaching the fatty acid esters of the combined references as fatty acid ester rosins would be within the skill of one in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the vitamin E of Clum et al. to the composition of the combined references because a) the combined references and Clum all teach emulsions comprising fatty alcohol esters; b) the combined references and Clum all teach cosmetics; c) Clum teaches antioxidants, such as vitamin E, as stabilizing compositions; thus, since Clum teaches vitamin E as a stabilizer in emulsions for cosmetics, one would expect the antioxidant to have similar properties in other cosmetic emulsions; hence, the addition of vitamin E to emulsions would be within the skill of one in the art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on T-F (6-4:30).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on (703) 308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw
February 6, 2002


DAMERON JONES
PRIMARY EXAMINER